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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,671	01/17/2002	Amr M. Mohsen	003921.00248	6141

22907 7590 02/02/2006

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WASHINGTON, DC 20001

EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2128

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,671

Applicant(s)

MOHSEN, AMR M.

Examiner

Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 of U. S. Application 10/052,671, were originally filed on 1/17/2002. An office action rejected claims 1-22. However, those claims had been canceled in a preliminary amendment and replaced with claims 23-58; thus the office action did not address the claims of record. Claims 23-58 were also canceled, *subsequent* to the office action of 7/12/2005 and replaced with new claims 59-73 in a *second* preliminary amendment. Applicants were also asked to supply highly relevant material to the office regarding litigation. No information has been supplied in the six intervening months.

Non-Responsive Amendment

2. The reply filed on 11/10/2005 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicants were requested to provide current information pertaining to related litigation and results of the litigation of said patent and whether it impacts prosecution of the instant application. In response, Applicants stated that "... is presently gathering information about the litigation that may be relevant to the present application. Applicant's representative has not had the opportunity to gather such information in time to include with the present response. However, Applicant's representative will separately provide any relevant information to the U.S. Patent and Trademark Office as soon as possible."

3. It is noted that the *request* was made to Applicants on 7/12/2005, over six months ago. No information has been forthcoming. Furthermore, please note that the Examiner will decide what is relevant to the examination of the application.

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4. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

5. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Requirement for Information under 37 CFR 1.105

6. Applicants state (response of 11/10/2005):

"The new claims are similar to the claims issued in U.S. Patent 5,377,124 ("the '124 patent"), which is presently expired due to an unavoidable failure to pay a maintenance fee."

7. It is noted that the instant application is a continuation of U. S. patent 5,544,069 which in turn is a continuation of U S Patent 5,377,124, now expired. It is also noted that there has been extensive litigation on the '069 patent; see the enclosed printouts, listed on the 892 form. There appear to be questions regarding conception and reduction to practice of the claimed invention.

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8. Thus, information regarding the status of and litigation pertaining to these application is critical to proper and timely examination of the instant application.

9. Further, in view of the facts stated above regarding lack of response to the request for information, the information is now *required*.

10. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

11. Please provide all litigation pertaining to all applications in the chain of continuity, including, but not limited to patents 5,377,124 and 5,544,069.

12. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

- **please indicate the status of all applications in the chain of continuity;**
- **please indicate all results of litigation of all applications in the chain of continuity;**
- **please provide information pertaining to any aspect of litigation that may impact the instant application.**
- **Applicants state (response of 11/10/2005) that they claims are “similar” to the claims of the expired US Patent 5,377,124. Please indicate the difference between the claims of the ‘124 patent and the instant application. It is noted that there have been many issues related to double patenting in the chain of continuity, including the instant application.**

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13. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

14. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

15. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

or

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

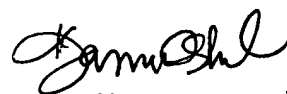
(703) 308-9051 (for formal communications intended for entry)

or (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

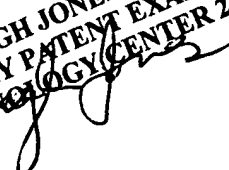
Dr. Hugh Jones

Primary Patent Examiner

January 27, 2006



KAMINI SHAH
SUPERVISORY PATENT EXAMINER



HUGH JONES Ph.D.
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